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EXAMINER

MOSSER, ROBERT E

ART UNIT PAPER NUMBER

3714

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/924,250

Applicant(s)

ROWE ET AL.

Examiner

Robert Mosser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The drawings were received on 8/29/03. These drawings are accepted.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-4, 5-7, 9, 11-15, 19-24, 27, 30-32, 34, and 36-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Saunders (US Pat 6,547,664).

Regarding claims 1, 3, 6, 19, and 23, Saunders teaches a promotional device having a indicia of credit associated therewith for effecting operation of at least one specific gaming application on a gaming machine which is in communication with the promotional device, the promotional device identifying the at least one specific gaming application and limiting the use of credit thereto. The promotional device is used in

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conjunction with a gaming machine comprising circuitry for receiving encoded information from the promotional device, and a processor configured to determine whether the application is associated with the gaming machine and in the case of establishing association further enabling operation of the at least one gaming application in accordance with the credit (See Figure 1 & Col 7:34-8:16). Wherein the determination and enablement based on said determination of the at least one gaming application is provided for by those gaming machines equipped with the system as described or alternatively those gaming applications present on the machines attached to the network.

Regarding claims 2 and 4, and in addition to the above stated, the promotional device further includes visual elements representing the gaming applications (See Figure 3; TickeTrak).

Regarding claims 5 and 7, and in addition to the above stated, the promotional device may comprise a printed ticket wherein the indicia of credit may comprise a barcode or in the alternative a card wherein the indicia of credit is encoded onto a magnetic stripe (See Col 1:50-61 & Col 7:43-53).

Regarding claim 9 and in addition to the above stated, the use of a magnetic strip (as cited above) is by definition the use of a magnetic memory (or equivalent magnetic strip) and hence a memory as so claimed.

Regarding claims 11-13, 20, 21 and 27, and in addition to the above stated, Saunders teaches the permanent storage of the information encoded on the ticket (including cash-in value, player name and/or player ID number) within a central

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computer (See Figure 1 and Col 7:41-61), which reads on a gaming machine is part of a gaming network which includes a remote storage device, at least part of the indicia of credit being stored in the remote storage device and the promotional device identifies the user as part of the indicia of credit stored on a remote device..

Regarding claims 14 and 30- 32, and in addition to the above stated Saunders teaches the use of a PIN for identification of a player authorized to redeem credit (See Col 7:62-8:15)

Regarding claim 15 and in addition to the above stated Saunders teaches the insertion of the promotional device into a slot/receptacle (430) of the gaming machine to facilitate communication (See Col 7:62-65 & Col 5:44-6:2).

Regarding Claim 22 and in addition to the above stated Saunders teaches the use of a barcode reader (560) and a magnetic card reader (670).

Regarding claim 24 and 34, and in addition to the above stated Saunders teaches the use of a gaming machine in a network (See Figure 1) including a game server (40) that enables game play through reading a ticket at the machine and validating the information read through the game server before enabling game play (See Col 6:61-66). Wherein the object associated with game play and distributed between the gaming application and the server is the credit validation.

Regarding claims 36 and 37 and in addition to the above stated Saunders teaches limiting the use of the player ticket to machines equipped with the reader and attached to the central computer and teaches that the system is compatible with a

variety of game machines. This results in limiting the use of the ticket to use on the network it was issued on and venues available on said network.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 8 and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Saunders (US 6,547,664).

Regarding claims 8 and 10 and in addition to the above mentioned. While Saunders is silent on the use of a incorporating the application identification information into the barcode, magnetic information or equivalent memory of the promotional device, he does use it for a variety of other information in order to help prevent fraud (Col 8: 11-15). It is well known to use the barcodes, magnetic information and memory to identify the application for which a device containing such is intended. This point is readily appreciable with such basic examples a such as <sup>lotto</sup> tickets, credit cards, and the <sup>mul</sup> validation codes used in similar gaming systems. It would have been obvious for one of ordinary skill in the art at the time of invention to incorporate the information included in the afore mentioned forms on the promotional device in order to provide an additional means of device validation and protect against fraud.

4. Claims 16-18, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saunders (US 6,547,664) in view of Mish et al (US 6,254,006).

Regarding claims 16 and 35 and in addition to the above disclosed Saunders teaches a cashless method of gaming including means for transferring data both through barcode and through magnetic strip but is silent on the use of wireless transmission. Mish teaches the use of Wireless communication devices and methods of forming the afore mentioned. Further Mish teaches the use of the parent technology of his invention or specifically smart cards with gaming machines (See Col 1:30-35). It would have been obvious for one of ordinary skill in the art at the time of invention to have used wireless transmission in place of contact transmissions as mentioned above

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in order to provide a system that would be subject to less mechanical wear and provide fewer avenues for debris to enter the body of the gaming machine.

Regarding claims 17-18 and in addition to the above disclosed. The invention of Saunders/Mish further includes visual elements representing the gaming applications (See Figure 3 Saunders; TickeTrak) for indicating the at least one gaming venue in which the promotional device may be employed.

5. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saunders (US 6,547,664) in view of Luciano et al (US 6,500,067).

In addition to the above disclosed Saunders teaches the connection of a plurality of gaming machines and cashiers to a central computer (See figure 1) but does not specify the means by which they are networked together. Luciano et al discloses a voucher gaming system LAN interconnected system components including a plurality of terminals, a central server and cashier terminals (See Col 3:65-4:18). It would have been obvious for one of ordinary skill in the art at the time the invention was made to have used a LAN type network for the network as describe in the invention of Saunders et al in order to provide a network that is readily adaptable to the addition and removal of components such as cashier stations.

1. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saunders (US 6,547,664) in view of Stern (US 6,110,044).



In addition to the above disclosed Saunders teaches a cashless gaming system comprising of multiple game machines interconnected for enabling the cashless ticket systems only and is silent on making this process stand-alone. Stern teaches a method for issuing and validating gaming tickets that is implemented in a stand-alone process (Col 3:24-41). It would have been obvious for one of ordinary skill in the art at the time of invention to have implemented the system through stand alone devices in order to prevent the network installation expenditures for the smaller casinos.

2. Claims 28, 29, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saunders (US 6,547,664) in view of Walker et al (US 6,227,972).

In regards to claims 28 and 29 and in addition to the above disclosed Saunders teaches a cashless method of gaming including the transfer of credit but is silent on altering service associated the specific user on at least one application dependent on their credit. Walker et al teaches the altering of services such as availability, credit, and inclusion/exclusion of a player tracking number (See Figure 5) in a method and apparatus for expiration of prepaid slot machine plays. It would have been obvious for one of ordinary skill in the art at the time of invention to have altered the services in accordance with a players credit in order to allow the establishments to custom their promotions to each individual.

In regards to claims 33 and in addition to the above disclosed Saunders teaches a cashless method of gaming including a player card but is silent on a player tracking service associated with the card. Walker et al teaches the use of player tracking services in conjunction with a player card (See Figure 5) in a method and apparatus for expiration of prepaid slot machine plays. It would have been obvious for one of ordinary skill in the art at the time of invention to have incorporated player tracking with a player card in order to allow the users improved satisfaction.

3. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bergeron (US Pat 4,764,666)..

Bergeron teaches an on-line wagering system with programmable game entry cards. The cards contain indicia of credit effecting the operation of at least one specific gaming application on an on-line gaming wherein the promotional device identifies the specific gaming application (32) and limits the use thereto. While Bergeron is silent on this online connection being an Internet site it would have been obvious to one of ordinary skill in the art at the time of invention to utilize an internet site in the system of Bergeron in order to provide a controlled application that does not require a specialized telecommunications network and is more readily available

### ***Response to Arguments***

4. Applicant's arguments filed 8/29/03 have been fully considered but they are not persuasive.

The applicant has argued that Saunders fails to teach the limiting of the device use to at least one specific gaming application and identifying said gaming application for which the use of said device is limited there to, however as shown below and in the prior office action mailed 7/30/03 the teachings of Saunders provides for both of the above mention limitations

5. In regards to the claim language of "Specific gaming application". A specific gaming application fails to specify a specific game title and/or version of said game title if so intended. A specific gaming application may readily be interpreted as slot (fruit) machine games and thereby include a vast number of game titles and types. In similar fashion one might readily consider Poker to be a specific gaming application though it may be present on several different machines in many different versions or variations (i.e. Five Card Stud). Thus as presented this identification may just as ready be understood to be the identification of the specific gaming application present in casino XYZ and thereby including any gaming application present in that casino.

In regards to the arguments addressed to the Saunders (US 6,547,664) reference: The applicant is directed to the citations cited in the previous office action in addition to column 6:55 through column 7:6 wherein Saunders describes his ticket system as employing a validation method including the comparison of the ticket data by a central computer (40) in order to validate the use of said ticket and the associated cash-in value of said ticket on a gaming machine. This clearly represents a limiting of the device's use in the following manners:

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- a. The specific gaming application must be connected to a ticket-reading device (10) capable of reading and garnishing the information presented on the ticket. As this ticket reading equipment is dependent on the size, shape, and arrangement of data and encoding method of data dependent on the ticket this requires a ticket-reading device that is not readily present on all gaming machines and hence forms a first limiting component by functional necessity.
- b. The specific gaming application must be associated/connected to a central server that would be capable of validating the ticket for use and as such this second limiting component is resultant of the device's reliance on a central computer for authentication/use and is clearly shown in Figures 1 through 3.

*MS*  
c.

Thus as presented the invention of Saunders has clearly limited the use of his ticket to those devices equipped with the ticket reading device and connected to the central server capable of validating the ticket and equivalently described as "limiting of the device use to at least one specific gaming application",

In addition Saunders teaches the identification of the specific gaming application for which the use of said device is limited to through the encoded data presented on the ticket, the ticket configuration, and the identification of the casino provided for in element 220 in the following manner:

- a. The encoded data present on the ticket and validation system of Saunders serves to readily indicate the specific gaming device for which the ticket may be

used by whether or not it can be validated by the central server to which the specific gaming application is connected.

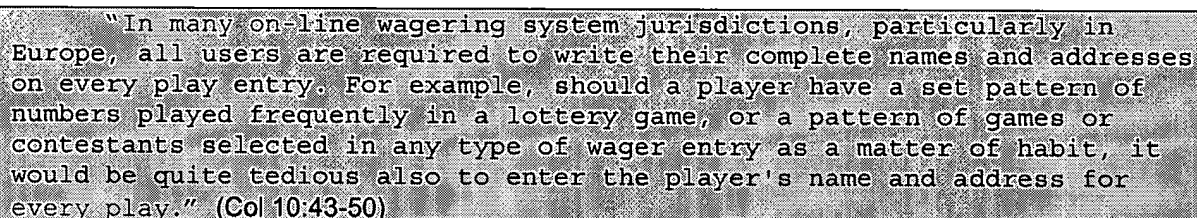
b. The features of the ticket configuration as described above to include size, shape, and arrangement of data and encoding method of data, serves to first limit the use of the ticket to devices equipped with the correct ticket readers and second limit the use to those device connected to a central server. As the ticket reader is readily visible as installed on the machine as displayed in element 10 in figure 1 and the ticket serves as an indication of which specific gaming applications the ticket may be used on. Thus in as much as the ticket reader is visible to the user and the user associates the ticket with a reading device that accepts the ticket, the ticket serves to indicate which specific gaming application for which it may be used.

c. The identification of the casino as present in large print on the gaming ticket in combination with the directions for use of the ticket with the TicketTrak system (Figure 3) and hence clearly shows a visual indication of the specific gaming application for which the ticket may be used by identifying those game machines and the location of said game machines (TicketTrak machines at a specific casino) for which the ticket may be used.

Thus the invention as present by Saunders teaches the limitation of "identifying said gaming application for which the use of said device is limited there to" as so claimed and with respect to the features as described above.

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6. The applicant has argued that Bergeron fails to teach the use of his invention for a specific gaming application however the applicants first citation (Col 2:20-34) is located in the background of the invention section and when taken in it's entirety (Col 2:20-53) merely serves to describe the type gaming applications to which his invention may be applied. The second citation presented by the applicant (Col 10:43-50) describes multiple possible embodiments of the invention as shown below,



"In many on-line wagering system jurisdictions, particularly in Europe, all users are required to write their complete names and addresses on every play entry. For example, should a player have a set pattern of numbers played frequently in a lottery game, or a pattern of games or contestants selected in any type of wager entry as a matter of habit, it would be quite tedious also to enter the player's name and address for every play." (Col 10:43-50)

This again however this bares no weight on the argument of whether or not a specific gaming application may or may not include multiple games as so described in of itself nor in the language of the claim which includes the phrase "At least one" thereby allowing for multiple games. Further more the prelude to the applicant's citation of "a pattern of games cited" is "set pattern of numbers played frequently in a lottery game" which would seem to imply that Bergeron also considered that a lottery may only include one game.

The applicant's interpretation of text 32 as shown in figure 1 and specifically "XYZ Lottery" in the Bergeron seems to only be a possible interpretation. While the text is directed to be a generic reference that is not specific to any one particular well know game it is provided for in capitalized letters and therefore interpreted as a proper name

referring to a particular game or specific gaming application and as such provides sustentative basis for the interpretation laid forth in the prior action. Alternatively even if the text was interpreted to read merely as citing a particular Lottery and a collection of games there of comprising this would still present an interpretation well within the bounds of "at least one specific gaming application" in so much as the over all specific gaming application is a lottery. Alternatively the inclusion of the phrase "at least" in the claim language ready presents the ability to include by definition multiple specific games that may be identified by their common name of the XYZ Lottery.

### ***Conclusion***

7. The following prior art is made of record and not relied upon is considered pertinent to applicant's disclosure.

Weiss (US 6,511,377) discloses a cashless gaming system: apparatus and method.

Seidman (US 5,080,364) discloses a gaming method and machine readable codes.

Pease et al (US 5,326,104) discloses a secure automated electronic casino gaming system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (703)-305-4253. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

REM

A handwritten signature in black ink, appearing to be 'MS', with a long horizontal flourish extending to the right.

MARK SAGER  
PRIMARY EXAMINER